

REMARKS

Upon entry of the foregoing Amendment, claims 1 and 4-40 are pending in the above-identified application. Applicant seeks to amend claims 1, 32, 33, 35, and 36. New claim 40 is sought to be added. These changes to the claims are supported by the application as originally filed, and do not introduce new matter. Accordingly, entry of the foregoing Amendment is respectfully requested.

Claim Rejections – 35 U.S.C. §112

First Paragraph

In the Office Action, the Examiner sustains the rejection of claims 1 and 4-39 under the first paragraph of 35 U.S.C. §112, alleging that the specification “does not reasonably provide enablement for the transaction” and that “technical steps required to illustrate the details of how the transaction is implemented are missing.” Paper No. 7898676, page 3. The Examiner further alleges that “the explanation of how the invention actually works and is implemented does not clearly enumerate enough details to enable recreation of the invention by one of ordinary skill.” Id. In the Examiner’s Response to Arguments, the Examiner comments:

The applicant still has not clarified exactly how the computer is associating the concepts with a value based on the value of the concept. It is not clear what “value of the concept” really means from the claims. Thus, the 112 rejection stands. Id, emphasis added.

Applicant interprets the above comment to read that the Examiner does not understand “how the computer is associating the concepts with an instrument based on the value of the concept... [and it] is not clear what “value of the instrument” really means.” It appears as if the Examiner is not giving adequate consideration to the language “each of the instruments being capable of being valued based on the value of the associated one or more concepts,” as recited in the previously presented claims. Applicant considers this language to be definite and fully enabled by the Applicant’s specification.

Although Applicant respectfully disagrees with the Examiner’s characterization of the previously presented claims, Applicant has amended independent claims 1, 32, 33, 35, and

36, and believes that the Examiner's rejection is now moot in light of the Amendment herein.

For example, independent claim 1 has been amended to recite:

allowing transactions in a set of one or more instruments on a networked computer system, each of the instruments being associated with one or more concepts, and each of the instruments being valued based at least in part on a utilization of the associated one or more concepts by one or more participants to locate information through the computerized searches.

As supported by Applicant's specification, claim 1 recites a method that allows the marketing (e.g., trading, exchanging, buying, selling, transacting, or the like) of "concept-based instruments." See Applicant's specification at page 10, lines 9-11; and page 14, lines 16-18. The concept-based instruments are valued in accordance with an algorithm that quantifies the utilization (e.g., demand, popularity, etc.) of certain "concepts" by a plurality of participants within a networked community. See Applicant's specification at page 6, lines 11-19. The frequency of utilization can be proportionally related to the value of the concept-based instrument, and the instrument's value can be predicted or estimated to allow the concept-based instrument to be applied as, for example, a hedging tool, speculating tool, market forecasting tool, or data generating tool. See Applicant's specification at page 8, lines 19-20.

Therefore, Applicant respectfully requests reconsideration and withdrawal of the above rejection, and allowance of claims 1 and 4-39, and allowance of new claim 40.

Second Paragraph

In the Office Action, the Examiner sustains the rejection of claims 1 and 4-39 under the second paragraph of 35 U.S.C. §112, alleging that the claims are "incomplete for omitting essential elements, essential steps and essential structural cooperative relationships of elements, such omission amounting to a gap between the elements." Paper No. 7898676, page 3. The Examiner alleges that the essential elements omitted are "the exact steps needed to implement the invention so that it can be re-created by one of ordinary skill" and that the claims are too broad insofar as they "do not indicate how the value of the instruments are

established based on the associated one or more concepts. Id. Although Applicant respectfully disagrees, this rejection is moot in light of the Amendment herein.

As explained above (with respect to the rejections under the first paragraph of 35 U.S.C. §112), independent claims 1, 32, 33, 35, and 36 have been amended to recite an embodiment for valuating a concept-based instrument. Applicant respectfully requests reconsideration and withdrawal of the above rejection, and allowance of claims 1 and 4-39, and allowance of new claim 40.

Claim Rejections – 35 U.S.C. § 103

In the Office Action, the Examiner sustains the rejection of claims 1, 4, 9-15, 20, 21, 25, 28-31, 33, and 34-39 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,794,233 to Rubinstein (herein “Rubinstein”) in view of U.S. Patent Application Publication No. 2002/0138445 to Laage *et al.* (herein “Laage”); claims 5-8, 17-19, 22-24, 26, 27, and 32 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Rubinstein and Laage, and further in view of U.S. Patent No. 6,269,361 to Davis *et al.* (herein “Davis”); and claim 16 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Rubinstein and Laage, and further in view of U.S. Patent Application Publication No. 2002/0091621 to Conklin *et al.* (herein “Conklin”). Paper No. 7898676, pages 4-16. Although Applicant respectfully disagrees, these rejections are now moot in light of the Amendment herein. For example, independent claims 1, 32, 33, 35, and 36 have been amended to recite language comparable to “allowing transactions in a set of one or more instruments on a networked computer system, each of the instruments being associated with one or more concepts, and each of the instruments being valued based at least in part on a utilization of the associated one or more concepts by one or more participants to locate information through the computerized searches,” which is not taught or suggested by Rubinstein, Laage, Davis, and Conklin, taken alone or in combination with each other. None of the above documents teaches or suggests “concept-based instruments” or the recited feature of valuating a concept-based instrument (e.g., at least in part on a utilization of one or more concepts by one or more participants...).

The dependent claims are patentable for additional reasons. While deemed unnecessary to argue these additional reasons at this time, given the arguments presented

above, the Applicant reserves the right to present such arguments should it become necessary or desirable to do so.

For the above reasons, Applicant respectfully requests reconsideration and withdrawal of the above rejection, and allowance of the pending claims, including new claim 40, which also recites features not taught or suggested by Rubinstein, Laage, Davis, and/or Conklin. To expedite prosecution, the Examiner is invited to contact the Applicant's undersigned representative.

Dated: March 13, 2006

Respectfully submitted,

By:


Kendrick P. Patterson, Reg. No. 45,321
BROWN RAYSMAN MILLSTEIN
FELDER & STEINER LLP
900 Third Avenue
New York, New York 10022
Tel : (212) 895-2000
Fax: (212) 895-2900
Customer No. 29858